

SMART & BIGGAR*Intellectual Property & Technology Law***To Fax no.:** (571) 273-8300**Page 1 of:** 27**Attention:** U.S.P.T.O.**Mail Stop:** - Appeal Briefs Patents

Mr. Reginald Tyson

Patent Appeals Specialist

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Fax (514) 954-1396**Date:** May 23, 2007**Time:** --**RECEIVED
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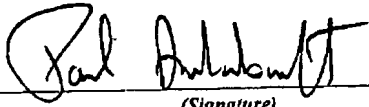
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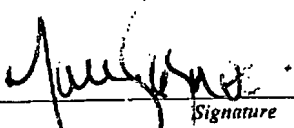
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MAY 23 2007

CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)			Docket No. 86421-39
Applicant(s): Ivan LABONTÉ			
Application No. 10/810,554	Filing Date March 29, 2004	Examiner Anthony D. Stashick	Group Art Unit 3728
Invention: SKATE BOOT COMPRISING A TONGUE			
<p>I hereby certify that this <u>AMENDED APPEAL BRIEF</u> (Identify type of correspondence) is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u>(571) 273-8300</u>) on <u>May 23, 2007</u> (Date)</p> <p><u>Paul W. Archambault</u> (Typed or Printed Name of Person Signing Certificate)</p> <p> (Signature)</p> <p>Note: Each paper must have its own certificate of mailing.</p>			

P18/REV02

MAY 23 2007

TRANSMITTAL LETTER (General - Patent Pending)				Docket No. 86421-39									
In Re Application Of: Ivan LABONTÉ													
Application No. 10/810,554	Filing Date March 29, 2004	Examiner Anthony D. Stashick	Customer No. 28291	Group Art Unit 3728	Confirmation No. 1238								
Title: SKATE BOOT COMPRISING A TONGUE													
<u>COMMISSIONER FOR PATENTS:</u>													
Transmitted herewith is: - AMENDED APPEAL BRIEF													
in the above identified application.													
<input checked="" type="checkbox"/> No additional fee is required.													
<input type="checkbox"/> A check in the amount of _____ is attached.													
<input checked="" type="checkbox"/> The Director is hereby authorized to charge and credit Deposit Account No. 19-2550 as described below.													
<input type="checkbox"/> Charge the amount of _____													
<input checked="" type="checkbox"/> Credit any overpayment.													
<input checked="" type="checkbox"/> Charge any additional fee required.													
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.													
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.													
 Signature			Dated: May 23, 2007										
Marc Gagnon, Reg. No. 51,273 SMART & BIGGAR 1000 De La Gauchetière Street West Suite 3300 Montreal, Quebec H3B 4W5 CANADA													
CC:													
<table border="1"><tr><td colspan="2">I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____</td></tr><tr><td colspan="2">(Date)</td></tr><tr><td colspan="2">Signature of Person Mailing Correspondence</td></tr><tr><td colspan="2">Typed or Printed Name of Person Mailing Correspondence</td></tr></table>						I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____		(Date)		Signature of Person Mailing Correspondence		Typed or Printed Name of Person Mailing Correspondence	
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P16A/REV04

Application No. 10/810,554
Amended Appeal Brief of May 23, 2007

PATENT
Attorney Docket No. 86421-39

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Title: SKATE BOOT COMPRISING A TONGUE
Application No.: 10/810,554
Applicant: Ivan Labonté
Filed: March 29, 2004
Art Unit: 3728
Examiner: Anthony D. Stashick
Confirmation No.: 1238
Docket No.: 86421-39

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AMENDED APPEAL BRIEF UNDER 37 C.F.R. 1.191

Commissioner of Patents
Alexandria VA 22313-1450
U.S.A.

Sir:

The following is the Appellant's amended Appeal Brief in response to the Notification of Non-Compliant Appeal Brief of May 7, 2007.

I Real Party in Interest

The real party in interest is the assignee of record, i.e. Bauer Nike Hockey Inc., 1200 Internationale Street, St-Jérôme, Quebec, Canada, J7Y 5G2.

II Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly affected by or have a bearing on the present appeal.

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III Status of Claims

Claims 1 to 25 are rejected.

The present appeal is directed to claims 1 to 25.

IV Status of Amendments

No amendment has been made subsequent to issuance of the Final Action of August 22, 2006.

V Summary of the claimed subject matter

As indicated in the Appellant's specification, at page 1, lines 16 to 22, it is known to manufacture tongues for skate boots, but there is a need for an improved tongue:

"However, a deficiency with existing tongues is that they may restrict the wearer's range of ankle movement and they may not provide sufficient protection to the wearer's forefoot, specifically for hockey players who play at the defense position and are more subject to receiving hard shots on their forefoot.

Against this backdrop, there is a need in the industry for a tongue that may increase the freedom of ankle movement and provide further protection for the wearer's forefoot."

The Appellant has made a significant advance in the art of hockey skate boot construction by realizing a skate boot with a tongue comprising a first section covering the forefoot of the foot; and a second section connected to said first section via a flexing zone, the flexing zone enabling the second section to be movable between a first position, in which the second section covers a portion of the front ankle portion of the foot of the player, and a second position, in which the second section overlaps a portion of the first section, wherein, in use, the player can fold the second section over the first section for wearing the skate boot with the tongue in the second position.

1. Subject matter defined by independent claim 1

Independent claim 1 reads as follows:

1. A skate boot for enclosing a foot of a player, the foot having a forefoot and a front ankle portion, said skate boot having a tongue comprising:
 - a) a first section covering the forefoot of the foot;
 - b) a second section connected to said first section via a flexing zone, said flexing zone enabling said second section to be movable between a first position, in which said second section covers a portion of the front ankle portion of the foot, and a second position, in which said second section overlaps a portion of said first section, wherein, in use, the player can fold said second section over said first section for wearing said boot with said tongue in said second position.

As indicated in the Appellant's specification, at page 6, lines 6 to 23:

"As better shown in Figures 4 and 5, the tongue 20 comprises a first section 40 and a second section 42, the second section 42 being connected to the first section 40 via a flexing zone 48. The flexing zone 48 enables the second section 42 to be movable between a first position and a second position in relation to the first section 40.

In the first position, as shown in Figures 3, 4 and 5, the first section 40 covers the forefoot FF and a portion of the front ankle portion FAP, while the second section 42 covers another portion of the front ankle portion FAP.

In the second position, as shown in Figures 6 and 7, the second section 42 overlaps a portion of the first section 40. When the second section 42 of the tongue 20 is in the second position, the second section 42 provides further protection and padding to the forefoot FF. In addition, in the second position, the second section 42 is no longer positioned in front of the front ankle portion FAP, thereby increasing the freedom of movement of the ankle. In fact, for a player who wears a leg pad that is long enough to cover the front ankle portion FAP, the player may then fold the second section 42 over

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the first section 40 since his/her leg pad offers enough protection for his/her front ankle portion FAP."

2. Subject matter defined by independent claim 20

Independent claim 20 reads as follows:

20. A skate boot for enclosing a foot of a player, the foot having a forefoot and a front ankle portion, said skate boot having a tongue and an ankle portion with upper eyelets, said tongue comprising:

- a) a first section covering the forefoot of the foot;
- b) a second section connected to said first section via a flexing zone, said flexing zone being located slightly above said upper eyelets and enabling said second section to be movable between a first position, in which said second section covers a portion of the front ankle portion of the foot; and a second position, in which said second section overlaps a portion of said first section, wherein, in use, the player can fold said second section over said first section for wearing said boot with said tongue in said second position whereby further protection for a portion of the forefoot is provided.

This claim further specifies that the flexing zone is located slightly above the upper eyelets of the skate boot.

As indicated in the Appellant's specification, at page 7, lines 7 to 12:

"In a non-limiting embodiment, the flexing zone 48 may be located high enough relative to the front ankle portion FAP, such that it is located slightly above the upper eyelets 36. In such a position, the second section 42 can be folded over the first section 40 when the wearer has laced the skate boot up to the upper eyelets. In such an embodiment, the height of the flexing zone 48 will be in accordance with the height of the sides of the boot 10 and the height of the upper eyelet 36."

Claim 20 further adds that the player can fold the second section over the first section for providing further protection for a portion of the forefoot.

As indicated in the Appellant's specification, at page 6, lines 23 and 24:

"In that way, the second section 42 overlaps a portion of the first section 40 for providing further protection for a portion of the forefoot FF."

VI Grounds of rejection to be reviewed on appeal

The sole issue at appeal is whether the Examiner erred in rejecting:

- claims 1 to 3, 20, 21 and 25 under 35 U.S.C. §102(b) as defining an invention that is anticipated by U.S. Patent 6,381,877 (Filice);
- claims 4, 5, 15 to 17, and 22 under 35 U.S.C. §103(a) as defining an invention that would have been obvious over Filice in view of U.S. Patent 5,289,645 (Marega *et al.*);
- claims 6, 7, 18 and 19 under 35 U.S.C. §103(a) as defining an invention that would have been obvious over Filice and Marega *et al.* in view of U.S. Patent 5,341,583 (Hallenbeck);
- claims 8, 9 and 14 under 35 U.S.C. §103(a) as defining an invention that would have been obvious over the aforesaid cited patents as applied to claim 4; and
- claims 10 to 13, 23 and 24 under 35 U.S.C. §103(a) as defining an invention that would have been obvious over the aforesaid cited patents as applied to claim 9 and in view of U.S. Patent 6,738,937 (Baychar).

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VII Arguments

1. Rejection of claims 1 to 3, 20, 21 and 25 under 35 U.S.C. §102(b)

The Examiner suggests that claims 1 to 3, 20, 21 and 25 define an invention that is anticipated by Filice. However, to anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.¹ Furthermore, inherency may not be established by probabilities or possibilities.²

1.1 Patentability of claim 1

Independent claim 1 reads as follows:

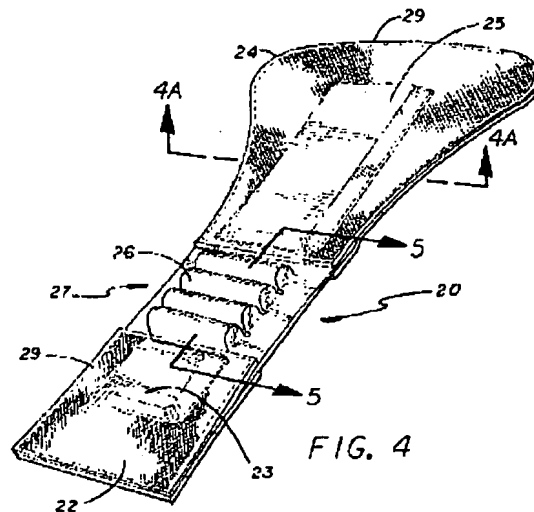
1. A skate boot for enclosing a foot of a player, the foot having a forefoot and a front ankle portion, said skate boot having a tongue comprising:
 - a) a first section covering the forefoot of the foot;
 - b) a second section connected to said first section via a flexing zone, **said flexing zone enabling said second section to be movable between a first position, in which said second section covers a portion of the front ankle portion of the foot, and a second position, in which said second section overlaps a portion of said first section, wherein, in use, the player can fold said second section over said first section for wearing said boot with said tongue in said second position.**

At page 2 of the Final Action, the Examiner indicates that Filice discloses a skate boot having a tongue 20 comprising a first section 22 covering the forefoot of the foot, and a second section 24 connected to the first section 22 via a flexing zone 26, this flexing zone enabling the second section 24 to be movable between first and second positions.

¹ In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

² In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)).

Figure 4 of Filice is reproduced hereinbelow in order to show the first and second sections 22, 24 and the flexing zone 26 identified by the Examiner:



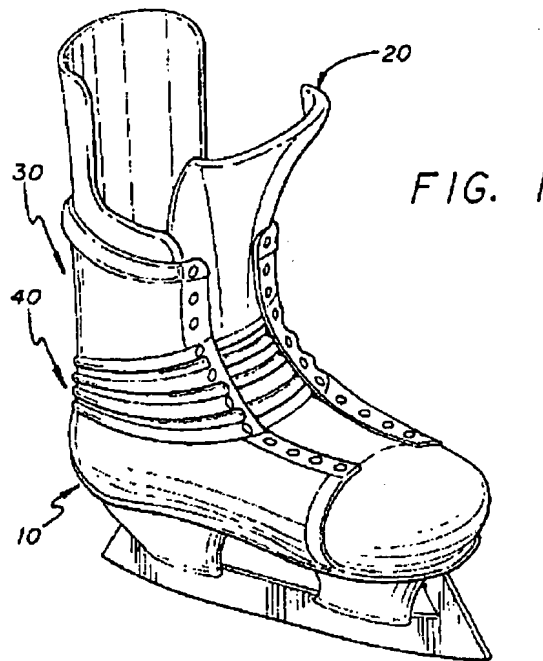
The Examiner also indicates that "in said second position, said second section overlaps a portion of said first section (fold 24 over 22 to insert foot into boot)". It appears that the Examiner considers that it is possible to fold the second section 24 over the first section 22 when the user inserts his/her foot into the boot.

Nowhere in Filice does the inventor teach or suggest that **the second section of the tongue overlaps a portion of its first section**, as recited in claim 1. Indeed, as seen in Figure 1 of Filice, because the flexing zone 26 is located well below the upper eyelets of the skate boot, a person skilled in the art would understand that, in use, when the boot is tied with the lace passing through the eyelets, it is impossible for the first section 22 to overlap the second section 24.

Figure 1 of Filice is reproduced on the next page.

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At page 5 of the Final Action, the Examiner suggests that “the user of the boot of Filice can wear the boot with the tongue overlapping during use since the boot does not need to be tied to “use” it, i.e. when walking.” The Appellant totally disagrees with this Examiner’s assertion since a person skilled in the art perfectly knows that a player cannot properly use a skate boot if it is not laced up.

Moreover, from a proper reading of Filice, a person skilled in the art would understand that the flexing zone 26 of the tongue 20 is aligned with the flexible ankle cuff section 40 of the skate boot to provide greater flexibility to the skate boot and the object of the flexing zone 26 is therefore to add flexibility, not to allow overlapping of a second portion over a first portion as recited in claim 1:

“As shown in the drawings, particularly FIG. 8, the flexible cuff section 40 is aligned with the flexible tongue section 26 when the boot is laced such that the ankle is essentially completely encircled by a flexible cuff.” [Filice, column 4, lines 11 to 14]

Furthermore, nowhere in Filice does the inventor teach or suggest that the player, **in use, can wear the boot with the second section of the tongue overlapping its first section**, as recited in claim 1.

As indicated in the Appellant's specification, at page 6, lines 20 to 24, the tongue allows "a player who wears a leg pad that is long enough to cover the front ankle portion FAP, [...] to fold the second section 42 [of the tongue] over the first section 40 since his/her leg pad offers enough protection for his/her front ankle portion FAP. In that way, the second section 42 overlaps a portion of the first section 40 for providing further protection for a portion of the forefoot FF."

Figure 7 of the Appellant's patent application is reproduced hereinbelow in order to show how the player can, in use, fold the second section of the tongue over its first section:

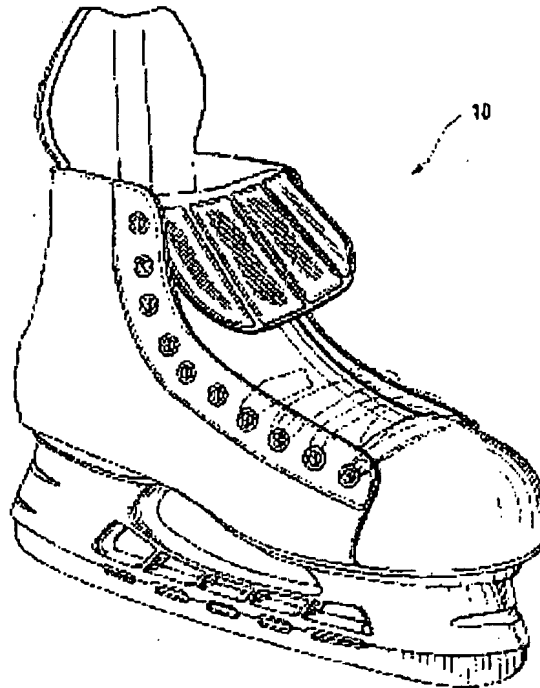


FIG. 7

Filice does not therefore disclose nor suggest a skate boot having a tongue:

- with a flexing zone enabling the second section to overlap a portion of the first section; and
 - that allows the player, in use, to fold the second section of the tongue over its first section for wearing the boot with the tongue in this position,
- as recited in claim 1.

Because of these two (2) important distinctions, the invention defined in claim 1 is clearly patentable over Filice and allowance of this claim is earnestly solicited.

1.2 Patentability of claims 2 and 3

Because claims 2 and 3 depend directly or indirectly from claim 1 and include by reference all of the features recited in claim 1, claims 2 and 3 are also patentable and allowance of these claims is earnestly solicited.

Moreover, with respect to claim 2 that specifies that the first section, the second section and the flexing zone are integrally formed, at page 2 of the Final Action, the Examiner indicates that “said first section, said second section and said flexing zone [of the Filice tongue] are integrally formed (multiple pieces fastened together meets the definition of ‘integral’, se [sic] Figure 4)”. The Appellant totally disagrees with this Examiner’s assertion.

As indicated in the Appellant’s specification, at page 8, lines 1 to 8:

“In the non-limiting embodiment shown in Figures 4 to 6, the first section 40, the second section 42 and the flexing zone 48 of the tongue 20 are integrally formed such that there is no separation of material between the three components. As such, the flexing zone 48 is formed of the same material as the first section 40 and the second section 42.”

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The term "integrally" as used in claim 2, does not cover a construction where multiple pieces are fastened together, as suggested by the Examiner, and claim 2 is therefore clearly patentable over Filice.

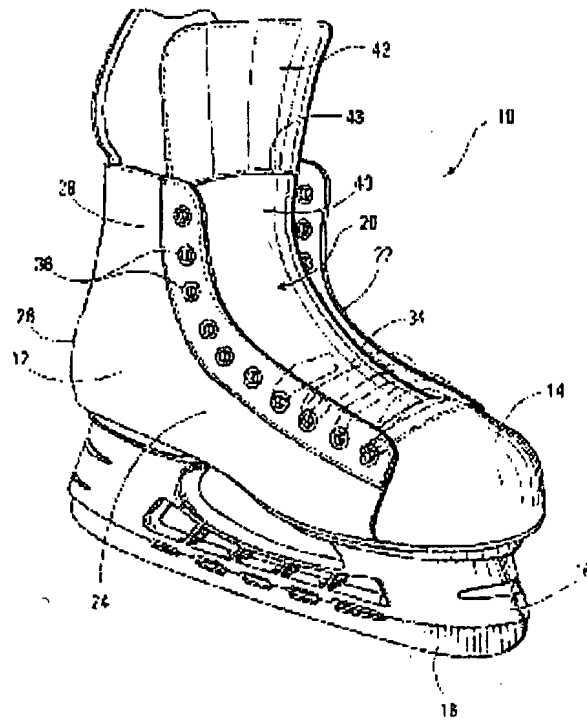
1.3 Patentability of claim 20

Claim 20 reads as follows:

20. A skate boot for enclosing a foot of a player, the foot having a forefoot and a front ankle portion, said skate boot having a tongue and an ankle portion with upper eyelets, said tongue comprising:
- a) a first section covering the forefoot of the foot;
 - b) a second section connected to said first section via a flexing zone, **said flexing zone being located slightly above said upper eyelets and enabling said second section to be movable between a first position, in which said second section covers a portion of the front ankle portion of the foot; and a second position, in which said second section overlaps a portion of said first section, wherein, in use, the player can fold said second section over said first section for wearing said boot with said tongue in said second position whereby further protection for a portion of the forefoot is provided.**

For the same reasons mentioned in Section 1.1, Heading VII, the invention defined in claim 20 is also patentable over Filice.

Claim 20 further specifies that the flexing zone is located slightly above the upper eyelets of the skate boot, as shown in Figure 3 of the Appellant's patent application reproduced on the next page (see reference numeral 48):

**FIG. 3**

At page 2 of the Final Action, the Examiner indicates that "the flexing zone [of the Filice tongue is] located above the upper eyelets of the ankle portion". The Appellant totally disagrees with this Examiner's assertion since, as shown in Figure 1 of Filice, the flexing zone 26 is aligned with the flexible ankle cuff section 40 and is clearly located well below the upper eyelets.

Figure 1 of Filice is again reproduced on the next page.

1.4 Patentability of claims 21 and 25

Because claims 21 and 25 depend directly or indirectly from claim 20 and include by reference all of the features recited in this claim, the invention defined in these claims is also patentable and allowance of claims 21 and 25 is earnestly solicited.

2. Rejection of claims 4, 5, 15 to 17 and 22 under 35 U.S.C. §103(e)

The Examiner suggests that claims 4, 5, 15 to 17 and 22 define an invention that would have been obvious over Filice in view of U.S. Patent 5,289,645 (Marega *et al.*).

2.1 Patentability of claims 4, 5 and 15 to 17

For the Examiner to establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.). It is respectfully submitted that a *prima facie* case of obviousness has not been set out in the Office Action.

MPEP § 2142 (8th ed.) states as follows:

"The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

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As indicated previously, Filice does not disclose nor suggest a skate boot having a tongue:

- with a flexing zone enabling the second section to overlap a portion of the first section; and
 - that allows the player, in use, to fold the second section of the tongue over its first section for wearing the boot with the tongue in this position,
- as recited in claim 1.

Because claims 4, 5 and 15 to 17 depend directly or indirectly from claim 1 and include by reference all of the features recited in claim 1, and because claim 1 is patentable over Filice for the reasons mentioned in Section 1.1, Heading VII, claims 4, 5 and 15 to 17 are also patentable and allowance of these claims is earnestly solicited.

With respect to claims 4 and 16 that specify that the flexing zone comprise a V-shaped groove, at page 3 of the Final Action, the Examiner indicates that “Filice ‘877 does not teach the flexing zone comprising a V-shaped groove. Marega *et al.* ‘645 teaches that the flexing portion (middle portion of the tongue between 14 and 18) can have a V-shaped groove (see Figure 3, V-shaped groove is in the width of the tongue) located therein to aid in helping the tongue flex when being used.”

Nowhere however in Marega *et al.* do the inventors disclose or suggest a V-shaped groove. In fact, the terms “V-shaped groove” is simply not mentioned in Marega *et al.* and Figure 3 of Marega *et al.* does not at all show a V-shaped groove.

Claims 4 and 16 are therefore patentable over the references cited by the Examiner and allowance of these claims is earnestly solicited.

With respect to claims 5 and 17 that specify that the second section comprises at least one flexing region for enabling it to expand laterally as it moves from the first position to the second position, at page 3 of the Final Action, the Examiner indicates that “Filice ‘877 as applied above discloses all the limitations substantially as claimed including the section comprising at least on

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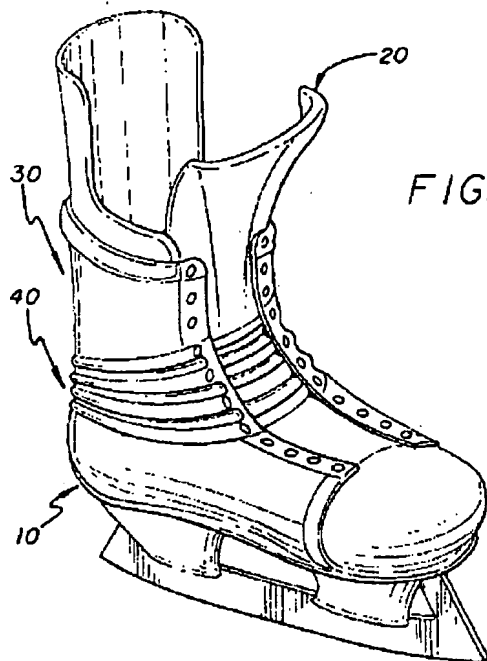


FIG. 1

Hence, nowhere in Filice does the inventor disclose or suggest a **flexing zone located slightly above the upper eyelets**, as recited in claim 20.

Moreover, nowhere in Filice does the inventor disclose or suggest that the player can fold the second section of the tongue over its first section for **providing further protection for a portion of the forefoot**, as recited in claim 20. In the Final Action, the Examiner has not specifically addressed this feature.

In view of the above, the Appellant submits that the invention defined in claim 20 is clearly patentable over Filice and allowance of this claim is earnestly solicited.

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[sic] flexing zone for enabling the second section to expand laterally as it moves from the first to the second position (see Figure 6, portion 28).”

Nowhere however in Filice does the inventor disclose or suggest that the second section comprises a flexing region for enabling it to expand laterally as defined in claim 5 and 17 and as shown in Figure 3 of the Appellant's patent application.

Figure 3 of the Appellant's patent application is again reproduced herein below (see flexing regions 42):

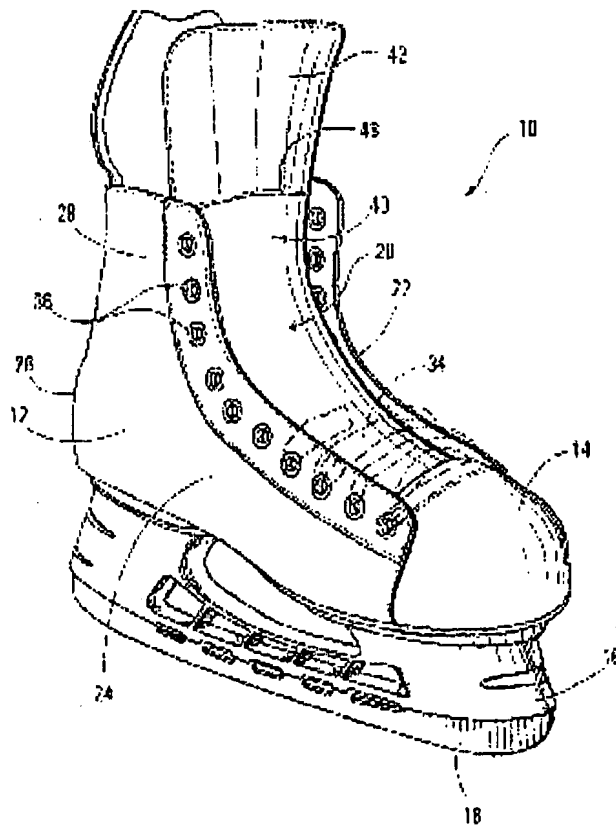


FIG. 3

Claims 5 and 17 are therefore patentable over the references cited by the Examiner and allowance of these claims is earnestly solicited.

2.2 Patentability of claim 22

Because claim 22 depends directly or indirectly from claim 20 and includes by reference all of the features recited in claim 20, and because claim 20 is patentable over Filice for the reasons mentioned in Section 1.3, Heading VII, claims 22 is also patentable.

Moreover, claim 22 specifies that the second section comprises at least one flexing region for enabling it to expand laterally as it moves from the first position to the second position; at page 3 of the Final Action, the Examiner indicates that "Filice '877 as applied above discloses all the limitations substantially as claimed including the section comprising at least on [sic] flexing zone for enabling the second section to expand laterally as it moves from the first to the second position (see Figure 6, portion 28)."

Nowhere however in Filice does the inventor disclose or suggest that the second section comprises a flexing region for enabling it to expand laterally as defined in claim 22 and as shown in Figure 3 of the Appellant's patent application (see flexing regions 42).

Allowance of claim 22 is therefore earnestly solicited.

3. Rejection of claims 6, 7, 18 and 19 under 35 U.S.C. §103(e)

The Examiner suggests that claims 6, 7, 18 and 19 define an invention that would have been obvious over Filice and Marega *et al.* in view of U.S. Patent 5,341,583 (Hallenbeck). Because claims 6, 7, 18 and 19 depend directly or indirectly from claim 1 and include by reference all of the features recited in claim 1, and because claim 1 is patentable over Filice for the reasons mentioned in Section 1.1, Heading VII, claims 6, 7, 18 and 19 are also patentable and allowance of these claims is earnestly solicited.

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4. Rejection of claims 8, 9 and 14 under 35 U.S.C. §103(e)

The Examiner suggests that claims 8, 9 and 14 define an invention that would have been obvious over the cited patents as applied to claim 4. Because claims 8, 9 and 14 depend directly or indirectly from claim 1 and include by reference all of the features recited in claim 1, and because claim 1 is patentable over Filice for the reasons mentioned in Section 1.1, Heading VII, claims 8, 9 and 14 are also patentable and allowance of these claims is earnestly solicited.

Moreover, with respect to claim 14 that specifies that the first section, the second section and the flexing zone are integrally formed, at page 4 of the Final Action, the Examiner indicates that "Filice '877 shows that the first section, flexing zone and the second section are integrally formed in as much that multiple parts fastened together meets the limitation of the term 'integrally formed'". Again, the Appellant totally disagrees with this Examiner's assertion.

As indicated in the Appellant's specification, at page 8, lines 1 to 8:

"In the non-limiting embodiment shown in Figures 4 to 6, the first section 40, the second section 42 and the flexing zone 48 of the tongue 20 are integrally formed such that there is no separation of material between the three components. As such, the flexing zone 48 is formed of the same material as the first section 40 and the second section 42."

The terms "integrally formed" as used in claim 14, does not cover a construction where multiple pieces are fastened together, as suggested by the Examiner, and claim 14 is therefore clearly patentable over Filice and the other references cited by the Examiner.

5. Rejection of claims 10 to 13, 23 and 24 under 35 U.S.C. §103(e)

The Examiner suggest that claims 10 to 13, 23 and 24 define an invention that would have been obvious over the cited patents as applied to claim 9 and in view of U.S. Patent 6,738,937 (Baychar).

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5.1 Patentability of claims 10 to 13

Because claims 10 to 13 depend directly or indirectly from claim 1 and include by reference all of the features recited in claim 1, and because claim 1 is patentable over Filice for the reasons mentioned in Section 1.1, Heading VII, claims 10 to 13 are also patentable and allowance of these claims is earnestly solicited.

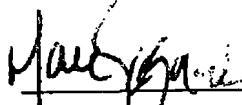
5.2 Patentability of claims 23 and 24

Because claims 23 and 24 depend directly or indirectly from claim 20 and include by reference all of the features recited in claim 20, and because claim 20 is patentable over Filice for the reasons mentioned in Section 1.3, Heading VII, claims 23 and 24 are also patentable.

Conclusion

For the foregoing reasons, it is submitted that the Examiner's rejections are not well founded, and reversal of his decision and allowance of claims 1 to 25 are earnestly solicited.

Respectfully submitted,



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VIII Claims appendix

1. (Previously presented) A skate boot for enclosing a foot of a player, the foot having a forefoot and a front ankle portion, said skate boot having a tongue comprising:
 - a) a first section covering the forefoot of the foot;
 - b) a second section connected to said first section via a flexing zone, said flexing zone enabling said second section to be movable between a first position, in which said second section covers a portion of the front ankle portion of the foot, and a second position, in which said second section overlaps a portion of said first section, wherein, in use, the player can fold said second section over said first section for wearing said boot with said tongue in said second position.
2. (Previously presented) A skate boot as defined in claim 1, wherein said first section, said second section and said flexing zone are integrally formed.
3. (Previously presented) A skate boot as defined in claim 2, wherein said first section is of a first thickness, said second section is of a second thickness and said flexing zone is of a third thickness, wherein said third thickness is less than said first thickness and said second thickness.
4. (Previously presented) A skate boot as defined in claim 3, wherein said flexing zone comprises a V-shaped groove.
5. (Previously presented) A skate boot as defined in claim 4, wherein said second section comprises at least one flexing region for enabling said second section to expand laterally as it moves from said first position to said second position.
6. (Previously presented) A skate boot as defined in claim 5, wherein said flexing region is of a fourth thickness, wherein said fourth thickness is less than said first thickness and said second thickness.
7. (Previously presented) A skate boot as defined in claim 6, wherein said flexing region comprises a groove extending substantially perpendicular to said flexing zone.
8. (Previously presented) A skate boot as defined in claim 4, wherein said tongue is formed of multiple layers of material.
9. (Previously presented) A skate boot as defined in claim 8, wherein said tongue comprises a first layer attached to a second layer.

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10. (Previously presented) A skate boot as defined in claim 9, wherein one of said first and second layers is made of foam.
11. (Previously presented) A skate boot as defined in claim 9, wherein both said first and said second layers are made of foam.
12. (Previously presented) A skate boot as defined in claim 11, wherein said first layer comprises an inner surface facing the foot, said first layer having a first density, said second layer having a second density, said second density being greater than said first density.
13. (Previously presented) A skate boot as defined in claim 11, wherein said foam is selected from the group consisting of ethylene vinyl acetate (EVA) foam, polyethylene foam, ethylene polypropylene foam and polyurethane foam.
14. (Previously presented) A skate boot as defined in claim 8, wherein said first section, said second section and said flexing zone are integrally formed.
15. (Previously presented) A skate boot as defined in claim 14, wherein said first section is of a first thickness, said second section is of a second thickness and said flexing zone is of a third thickness, wherein said third thickness is less than said first thickness and said second thickness.
16. (Previously presented) A skate boot as defined in claim 15, wherein said flexing zone comprises a V-shaped groove.
17. (Previously presented) A skate boot as defined in claim 16, wherein said second section comprises at least one flexing region for enabling said second section to expand laterally as it moves from said first position to said second position.
18. (Previously presented) A skate boot as defined in claim 17, wherein said flexing region is of a fourth thickness, wherein said fourth thickness is less than said first thickness and said second thickness.
19. (Previously presented) A skate boot as defined in claim 18, wherein said flexing region comprises a groove extending substantially perpendicular to said flexing zone.
20. (Previously presented) A skate boot for enclosing a foot of a player, the foot having a forefoot and a front ankle portion, said skate boot having a tongue and an ankle portion with upper eyelets, said tongue comprising:
 - a) a first section covering the forefoot of the foot;

- b) a second section connected to said first section via a flexing zone, said flexing zone being located slightly above said upper eyelets and enabling said second section to be movable between a first position, in which said second section covers a portion of the front ankle portion of the foot; and a second position, in which said second section overlaps a portion of said first section, wherein, in use, the player can fold said second section over said first section for wearing said boot with said tongue in said second position whereby further protection for a portion of the forefoot is provided.
21. (Previously presented) A skate boot as defined in claim 20, wherein said flexing zone comprises a V-shaped groove.
22. (Previously presented) A skate boot as defined in claim 21, wherein said second section comprises at least one flexing region for enabling said second section to expand laterally as it moves from said first position to said second position.
23. (Previously presented) A skate boot as defined in claim 21, said tongue comprises a first layer attached to a second layer, said first and second layers being made of foam.
24. (Previously presented) A skate boot as defined in claim 24, wherein said first layer comprises an inner surface facing the foot, said first layer having a first density, said second layer having a second density, said second density being greater than said first density.
25. (Previously presented) A skate boot as defined in claim 20, wherein said flexing zone is a first flexing zone, said tongue further comprising a second flexing zone located below said first flexing zone.

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IX Evidence appendix

None

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X Related proceedings appendix

None